

REMARKS INCLUDING STATEMENT UNDER 37 CFR 1.173(c)

This preliminary amendment is filed to amend the specification and claims; consideration of this application as amended is requested.

Specification Amendment

The specification is amended to insert a cross-note and state that the present application is a continuation of Application No. 10/119,775, filed April 11, 2002 which is a reissue application of Application No. 09/139,774, filed August 25, 1998, now U.S. Pat. No. 6,048,282.

Claim Amendment - Statement Under 37 CFR 1.173(c)

Claims 1-17 are in the case from parent reissue application No. 10/119,755. Claim 1 is amended to remove a number of amendments filed in the parent reissue application. More specifically, claim 1 is amended to reinsert the subject matter of claims 16 and 17, namely to add the elements "a pair of elongate flexible turf anchoring strips laterally outward of the outer bands of ribbons and secured to the backing;" and "ballast means on the backing for securing the marking strip within the trench, the ballast means comprising granular material disposed between the parallel rows of synthetic ribbons". With reference to patent claim 1, claim 1 in its present form refers to a second color of outer bands laterally adjacent the middle band, the second color selected to blend visually with that of the natural grass turf surface as introduced in the parent reissue application.

Claims 2 and 5 are amended to refer to claim 1 and are now identical to patent claims 2 and 5. Claims 3-4 and 6-15 remain untouched.

As noted, dependent claims 16 and 17 first introduced in the reissue application are canceled, the subjects matter thereof being reintroduced into claim 1.

By this preliminary amendment, new independent claims 18, 19 and 20 and dependent claim 21 are presented for consideration. The new claims are each directed to a method for visually marking lines in a natural grass turf surface. Support for these claims may be found chiefly at column 2, lines 33 to 60. Further support may be found at column 4, lines 52 to 55 concerning color; column 6, lines 53-56 for ribbons as synthetic grass; and column 3, lines 8-14 to specify that the outer bands serve to impede the growth of the natural grass from overgrowing onto the middle band. Tufting of the ribbons to the backing (new claim 20) is supported at column 6, lines 53 to 64, for example.

#### Recapture

Applicants submit that the new claims are allowable and do not recapture material surrendered in the original application for the patent upon which the present reissue continuation is based. The new claims are directed to a different aspect of the invention, namely a process. With reference to MPEP sections 1412.02 and 1412.03, applicants submit that the new claims are a permissible broadening of the invention. MPEP 1412.02 specifies criteria for determining that subject matter has been surrendered. That section provides "If the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the

claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists." As this method aspect was not in issue, applicants could not have surrendered this subject matter.

As noted in section 1412.03, the addition of process claims as a new category of invention to be claimed in the patent (i.e., where there were no method claims present in the original patent) is generally considered as being a broadening of the invention. See *Ex parte Wikdahl*, 10 USPQ2d 1546 (Bd. Pat. App. & Inter. 1989). However, since the reissue application was timely filed, applicant may seek to issue broadened claims.

In view of the information provided herein, it is respectfully submitted that claims 1-15 and 18-21 are in condition for allowance and the reissue (continuation) should be granted.

Dated September 25, 2003

Respectfully submitted,

Parkhurst & Wendel, L.L.P.

A handwritten signature in dark ink, appearing to read 'Charles A. Wendel', is written over a horizontal line.

Charles A. Wendel

Registration No. 24,453

Attorney Docket: SWAB:006B